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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,391	11/19/2003	Teruaki Itoh	160-398 (AMK)	5497
23117 7590 08/06/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER GORDON, BRIAN R	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 08/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,391

Applicant(s)

ITOH, TERUAKI

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-24-07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 24, 2007 has been entered.

Interview Summary

The examiner reviewed the amended claims and discovered the claims contained 112 issues (explained herein). In an effort to expedite the prosecution of the case the examiner phoned Mr. Kagan to clarify the issues in order to properly search applicant's intended invention. Authorization for this examiner's amendment was given in a telephone interview with Alan Kagan on July 31, 2007. However, the further searching revealing references that have been applied herein. As such the examiners amendment has not been entered the claims have been addressed as filed by applicant.

The proposed amendments is given as follows:

1. (Currently Amended) A specimen dispensing system comprising:
 - a master specimen container containing a specimen;
 - a required number of empty slave specimen containers;
 - a plurality of conveyor lanes;

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conveying means cooperable with the conveyor lanes for conveying the master specimen container and the empty slave specimen containers on the plurality of conveyor lanes, wherein the master and slave specimen containers are aligned on the conveyor lanes in a conveyance direction;

a dispensing unit means including a dispensing nozzle; and

stopping means for temporarily stopping the master and slave specimen containers when the master and slave specimen containers reach a position under the dispensing nozzle,

said dispensing means for ~~the dispensing unit~~ removing the specimen from the master specimen container by the dispensing nozzle when the master specimen container is temporarily stopped in the position under the dispensing nozzle and dispensing the specimen to the slave specimen containers when the slave specimen containers are temporarily stopped in the position under the dispensing nozzle, wherein a controller moves the dispensing unit nozzle ~~is movable~~ in a direction crossing the conveyor lanes.

2. (Currently Amended) The specimen dispensing system according to claim 1, further comprising a plurality of said dispensing units nozzles, wherein each of the dispensing units nozzles dispenses the specimen to the slave specimen containers from the master specimen container on the conveyor lane concurrently with dispensing operations on other conveyor lanes.

Cancel claim 3.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the dispensing nozzle being movable, does not reasonably provide enablement for the entire dispensing unit being movable as claimed.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

4. Claims 1-3 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The dispensing units were not previously disclosed as being movable. Furthermore it was not previously disclosed that the device comprises a plurality of dispensing units.

Double Patenting

5. Claim 3 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Stylli et al. US 5,985,214.

Stylli et al. disclose systems and methods that utilize automated and integratable workstations for identifying chemicals having useful activity.

The system provides for a liquid handling device (dispensing means) that aspirates from master plates (master specimen containers) and dispenses the fluid there from into daughter plates (slave containers).

An orthogonal positioner can typically match an array of dispensing heads (plurality of dispensing nozzles) with an array of wells in X,Y using a mechanical means to move the wells into position or the liquid handler (e.g., dispensing heads) into position. Preferably, arrays of wells on a plate are moved rather than the liquid handler (column 13, lines 25+)

The device incorporates a transport system (conveying means) that includes a plurality of lanes (column 20, line 13+).

The device is automated a computer, logic control system that is capable of controlling the positioning and transport (including temporarily stopping the containers) of the various components in the device (for example column 20, lines 44).

It should be noted the limitations of the claims are further disclosed throughout various unspecified locations.

8. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Watson et al. US 6,599,476.

Watson et al. disclose a system for aspirating from a primary container and dispensing to a secondary container. In one embodiment the cap of the primary container is removed and aliquots of the sample aspirated by the sample aspiration and/or dispensing means are dispensed to the secondary container or containers which are then sealed and labelled and placed in the storage means; and whereby the conveyance of the primary containers and secondary containers between operational steps is via the container conveyance means and the whole process is coordinated and controlled by a computerised laboratory information management system (column 7, lines 39+).

As seen in Figs 14 and 15, the device incorporates a plurality of lanes. As illustrated in Figure 5 the aspiration and dispensing means is movable across the lanes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, Telework Thurs., 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian R Gordon
Primary Examiner
Art Unit 1743



brg